REMARKS

Claims 1-26 were pending in the present application. By virtue of this response, claims 1, 8, 12-13 and 20 have been cancelled, and claims 2, 7, 9, 14, 17-19, 21 and 26 have been amended. Accordingly, claims 2-7, 9-11, 14-19 and 21-26 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Claims 1, 8, 12-13, 17-19 and 20 are rejected as being anticipated by Thome. Applicant has incorporated the features of independent claim 1 into claim 2; of independent claim 8 into claim 9; of independent claim 12 and claim 13 into claim 14; and of independent claim 20 into claim 21. As a result, the anticipation rejection is moot.

Claims 2, 9-11, 14-16 and 21 are rejected as being obvious over Thome in view of Macachor. The Examiner contends that Thome discloses everything in claims 2, 9, 14 and 21 except for specifically disclosing the request access parameters including a first address and a byte count value. The Examiner contends that Macachor discloses these alleged shortcomings of Thome. The Examiner specifically contends that "Macachor teaches in column 3, lines 49-53, transmission parameters for burst length, starting address, block size, block count, and byte count." Applicant respectfully traverses the rejection.

In particular, Applicant agrees with the Examiner's characterization as to what column 3, lines 49-53 of Macachor describe. However, Applicant disagrees with the Examiner's implication that it would be obvious to modify Thome such that access parameters on which the m-bit enable word of Thome (assuming, *arguendo*, that Applicant agrees that bits BE0* through BE7* of Thome constitute the m-bit enable word recited in the claims) are the "first address" and "byte count" disclosed by Macachor.

In the first place, Macachor itself does not provide such a suggestion, since the Macachor DMA controller does not appear to even disclose generating an "enable word" (let alone

pa-873124

an "m-bit enable word") based on the "first address" and "byte count." That is, the Macachor DMA controller appears to treat all of the accessed bytes as "valid."

Furthermore, even if the Examiner's assertion were true that it would be obvious for the Thome apparatus to include a starting address and byte count "in order to provide user control to vary transmission parameters," again, there is nothing to suggest that the bits BE0* through BE7* would be based on these parameters. After all, if the Thome apparatus can presumably sufficiently determine the bits BE0* through BE7* without resorting to using a starting address and byte count, why would the Thome apparatus do any different if the starting address and byte count were used as access parameters? Yet further, there is nothing in Macachor or Thome that discloses how one would go about determining the bits BE0* through BE7* from the starting address and byte count.

For at least these reasons, it is respectfully submitted that claims 2, 9, 14 and 21 are patentable over Thome and Macachor, whether taken alone or in combination. Claims 10-11 and claims 15-16 depend from claims 9 and 14, respectively. Therefore, claims 10-11 and claims 15-16 are patentable for at least the same reasons. Similarly, claim 7 has been amended to depend from claim 2; claims 17-19 have been amended to depend from claim 14; and claim 26 has been amended to depend from claim 21. Thus, claims 7, 17-19 and 26 are also patentable for at least the same reasons.

Finally, Applicant appreciates the Examiner's indication that claims 3-6 and 22-25 would be allowable if rewritten. As discussed above, Applicant respectfully submits that the base and intervening claims are allowable. Therefore, Applicant has elected to not rewrite claims 3-6 and 22-25 at this time.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 491442008900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: April 27, 2004

Respectfully submitted,

By_____
Alan S. Hodes
Registration No.: 38,185
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304
(650) 813-5622